

## **REMARKS**

Claims 1-19 and 27 are pending in the Application. The Applicants thank the Examiner for the courtesy shown during the interview with the Applicants' undersigned representative on August 9, 2006.

### ***Rejection Under §103***

#### ***1. The Combination of Wilkie, Pike and Curatolo***

During the interview the rejection based on the theoretical combination of Wilkie, Pike and Curatolo was discussed. The Applicants explained their position that there is no proper suggestion or motivation in any of the references of record, or in the general knowledge available to one skilled in the art at the time the application was filed, to use an energy-cured release layer on one side of a substrate in combination with a cold-seal cohesive coating on the other side of the substrate. Specifically, Wilkie describes a polypropylene cold-seal release film having a cold-seal receptive layer on one side and a cold-seal release layer on the other. The cold-seal release layer is a polymeric blend of ethylene-butylene copolymer with polypropylene, polyethylene or another polymer, which can be coextruded with the other layers of the Wilkie film. The release layer of Wilkie is not energy cured, nor does Wilkie provide any motivation to provide such a layer. Similarly, Pike provides no suggestion to use an energy-cured coating in combination with a cold-seal cohesive.

Curatolo describes a radiation-curable release coating for certain adhesives, including hot melt adhesive, pressure sensitive adhesive and any adhesive "which forms an aggressive adhesive bond to the substrate and to any other surface to which the substrate is adhered." As discussed in the Applicants' Response of November 22, 2005 ("the November 22 Response"), the adhesives described in Curatolo are of a different nature and have different bonding properties than the cold-seal cohesive of the present invention. *See also*, Supplemental Declaration of Scott Huffer accompanying the November 22 Response ("Supl. Huffer Decl.") ¶ 11.

As also discussed in the November 22 Response, the Board of Patent Appeals and Interferences has held that the interaction between two layers in a composite film is unpredictable. *See, Ex Parte Bader*, pp. 6-7, 2002 WL 31083124 (Bd. Pat. App. & Int. Feb. 4,

2002) (unpub.) (copy submitted with the November 22 Response). As such, one skilled in the art would not expect to achieve the same results if the release coating of Curatolo were used in combination with a cold-seal cohesive. *See also*, Supl. Huffer Decl. ¶ 12. Because of the different properties between the adhesives contemplated by Curatolo and the cold-seal cohesive of the present invention, and the unpredictability of layer interactions, one skilled in the art would have had no reasonable expectation of success in attempting to apply the release coating of Curatolo to a film having a cold-seal cohesive.<sup>1</sup>

At best, Curatolo provides an “obvious to try” scenario, which cannot be the basis for an obviousness rejection. In reversing such a rejection issued by the Patent Office, the Federal Circuit stated:

The PTO presents, in essence, an “obvious to experiment” standard for obviousness. However, selective hindsight is no more applicable to the design of experiments than it is to the combination of prior art teachings. There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant’s disclosure. Of the many scientific publications cited by [the applicant] and the PTO, none suggests that any process could be used successfully ... to produce this product having the desired properties.

*In re Dow Chemical Co.*, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988). Because of the unpredictability in the art and the differences in chemical and bonding properties between a cold-seal cohesive and the adhesives contemplated by Wilkie, one skilled in the art would have no reasonable expectation of success in applying the release coating of Curatolo to a film carrying a cold-seal cohesive on the other side. In such an “obvious to try” scenario with no reasonable expectation of success, Curatolo cannot be considered to provide an adequate motivation to combine references.

## 2. *The Non-migratory Slip Agents of Wilkie*

One of the advantages of using an energy-cured release coating as described in the present application is that the energy-cured release coating can include reacted-in slip agents that

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<sup>1</sup> As far as the Applicants are aware, no one before them had ever tested the release properties of an energy-cured coating with respect to a cold-seal cohesive.

will not bloom out of the coating and poison the cold-seal cohesive. No reference of record suggests this advantage of an energy-cured coating as the release layer. However, during the interview, the Examiner noted that Wilkie includes non-migratory slip-agents in the nature of talcs, silicas, glass beads, diatomaceous earth, clay or cross-linked silicone (2  $\mu$  particles). These materials are mechanical slip-agents, in that they create unevenness in the surface of the release layer in order to reduce the contact area between the layer and the surface in which it is in contact. During the interview, the Applicants explained that the Wilkie slip agents are neither found within an energy-cured layer, nor reacted into the polymeric layer in which they are found. However, the Examiner has taken the position that the non-migratory slip agents of Wilkie are “reacted-in”, because they may be entrapped within the polymeric release layer.

*a. “Reacted-in” Means Chemically Bound*

The meaning of the term “reacted-in” was discussed at length during the interview. During prosecution, the term “reacted-in” should be construed using its broadest reasonable interpretation. However, the broadest reasonable interpretation of the term must be consistent with the interpretation that those skilled in the art would reach. MPEP §2111 [R-1] (citing *In Re Cortright*, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)). Thus, to determine the correct meaning attributable to any claim term, one must consider the ordinary and customary meaning that the term would have to one of skill in the art. MPEP §2111.01(II) (citing *Phillips v. AWH Corp.* 75 USPQ2d 1321 (Fed. Cir. 2005)).

In construing the ordinary and customary meaning of a claim term, evidence from a variety of sources may be considered, including the prosecution history. MPEP §2111.01(II) (citing *Phillips, DeMalini Sports, Inc. v. Ritt, Inc.* 57 USPQ2d 1809, 1894 (Fed. Cir. 2001)). The ordinary and customary meaning of the term “reacted-in” was discussed at length in the November 22 Response and the accompanying Declaration of Scott Huffer, *i.e.*, part of the prosecution history. *See*, Supl. Huffer Decl. ¶¶ 5-7. As explained therein, the ordinary and customary meaning of the term as understood by one skilled in the art, is that the compound being described is chemically bonded to one or more compounds in its surrounding environment. Supl. Huffer Decl. ¶5. In the present case, the term “reacted-in”, as understood by one of skill in the art, means that the slip agent in the energy-cured coating is chemically bound to the polymer network. Supl. Huffer Decl. ¶7. This meaning is consistent with the specification. Supl. Huffer

Decl. ¶8. Thus, the Declaration of Mr. Huffer clarifies that one of ordinary skill in the art would understand the meaning of the term “reacted-in” as being chemically bound to the polymer network.

The reason that pending claims should be given their broadest reasonable interpretation during examination is to reduce the possibility that the claims, once issued, would be interpreted more broadly than is justified. MPEP §2111 [R-1] (citing *In re Prater*, 162 USPQ 541, 550-51 (CCPA 1969)). In the present case, the intrinsic evidence (*i.e.*, the specification, the November 22 Response and the accompanying Declaration of Mr. Huffer) clearly indicate that the term “reacted-in” means chemically bound to the polymer network. Therefore, there is no concern that, once issued, the claim could potentially be interpreted more broadly than is justified.

Accordingly, attributing the meaning of “chemically bound to the polymer network” to the term “reacted-in”, which is the interpretation that one skilled in the art would reach, is consistent with the letter and spirit of the rule of applying the broadest reasonable interpretation. Thus, the term “reacted-in” should be construed accordingly.

Based on the broadest reasonable interpretation of the term, Wilkie does not describe or suggest reacted-in slip agents. Wilkie also does not provide any suggestion or motivation to use an energy-cured release coating (with or without reacted-in slip agents) in combination with a cold-seal cohesive. As such, it is respectfully requested that the rejection under §103 be reconsidered and withdrawn.

### ***Double Patenting***

Claims 1-19 and 27 have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Pat. App. No. 10/794,100 (“the ‘100 application”) in combination with Wilkie. As explained in the November 22 Response and in the Applicants’ prior response of May 2, 2005, the ‘100 application has been expressly abandoned. A copy of the express abandonment was submitted with the Applicants’ response of May 2, 2005. In light of the abandonment, the double-patenting rejection should be withdrawn.

Claims 1-19 and 27 have also been provisionally rejected under the doctrine of obviousness-type double patenting over co-pending U.S. Pat. App. No. 10/702,980 (“the ‘980 application”). The ‘980 application is an involuntary divisional application of the present application, and was filed after an Office Action restricting method claims 20-24 out of this

application. The restricted method claims remain pending in the '980 application. Because the '980 application is an involuntary divisional application, the double patenting rejection should be withdrawn. MPEP § 804.

***Conclusion***

For the reasons set forth above, it is respectfully requested that all of the rejections and objections set forth in the Office Action be reconsidered and withdrawn. It is respectfully submitted that the application is now in condition for allowance, which action is earnestly solicited. If the Examiner believes that further minor amendments or correction as to matters of form will expedite allowance, the Examiner is invited to telephone the Applicants' undersigned representative.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Steven A. Nash", written in a cursive style.

Steven A. Nash  
Reg. No. 45,507  
Attorney for Applicants

SAN/vbm  
(215) 656-3305